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In re Application of FRISKNEY et al
U.S. Application No.: 10/593,108
PCT Application No.: PCT/GB2005/001332
Int. Filing Date: 06 April 2005
Priority Date Claimed: 06 April 2004
Attorney Docket No.: 920476-104020
For: DIFFERENTIAL FORWARDING IN
ADDRESS-BASED CARRIER NETWORKS

DECISION

This is in response to applicant's "Response to Decision Dated March 5, 2008" filed March 2008, which is being treated as a renewed petition under 37 CFR 1.497(d).

BACKGROUND

On 06 April 2005, applicant filed international application PCT/GB2005/001332, which claimed priority of an earlier United States application filed 06 April 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 20 October 2005. The thirty-month period for paying the basic national fee in the United States expired on 06 October 2006.

On 15 September 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 16 April 2007, applicant filed executed declarations.

On 11 May 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that the declaration filed 16 April 2007 omitted an inventor who was listed in the published international application.

On 21 May 2007, applicant filed a response to the Notification of Missing Requirements.

On 20 November 2007, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that applicant's 21 May 2007 response did not address the defect indicated in the Notification of Missing Requirements.

On 26 December 2007, applicant filed a petition under 37 CFR 1.497(d).

On 05 March 2008, this Office mailed a decision dismissing the 26 December 2007 petition.

On 12 March 2008, applicant filed the present renewed petition under 37 CFR 1.497(d).

DISCUSSION

The petition states that Mark Gibbon should be deleted as an inventor.

37 CFR 1.497(d) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

Petitioner has previously satisfied items (1), (2), and (4) above.

With regard to item (3) above, the original petition included a statement of written consent from the assignee Nortel Networks Limited ("Nortel"). Nortel has properly established ownership of the application in accordance with 37 CFR 3.73(b)(1) by submitting copies of assignment documents. However, the statement of consent either (1) is not signed by a person with apparent authority to sign on behalf of the assignee or (2) does not set forth that the person signing is authorized to act on behalf of the assignee. See MPEP 324, Section V.

MPEP 201.03, Section II D, states in relevant part,

The individual signing on behalf of the assignee giving its consent to the requested inventorship correction, should specifically state that he or she has the authority to act on behalf of the assignee. In the absence of such a statement, the consent will be accepted if it is signed by an appropriate official of the assignee (e.g., president, vice president, secretary, treasurer, or derivative thereof) if the

official's title has been made of record. A general statement of authority to act for the assignee, or on the specific matter of consent, or the appropriate title of the party signing on behalf of the assignee should be made of record in the consent. However, if it appears in another paper of record, e.g., small entity assertion, it is also acceptable.

In the present case, the individual, Daniel Hermele, signing on behalf of Nortel giving its consent to the correction of inventorship, has not stated that he has authority to act on behalf of the assignee. Mr. Hermelle does not have a title that confers apparent authority, such as chief executive officer, president, manager, director, vice-president, secretary, or treasurer. See MPEP 324, Section V (stating, "A person having a title (administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee.") Notwithstanding petitioner's assertion that similar documents signed by Mr. Hermelle have been previously accepted by the Office, the particular statement of consent submitted in the present application remains deficient for the reasons noted.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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